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In re application of Michael Seul et al. : DECISION ON PETITION
Serial No. : 09/448,420 :
Filed : November 23, 1999 :
Attorney Docket No.: 42970-3 :
:

This is in response to applicants' petition, filed March 8, 2004, to require the examiner to issue a new final rejection.

BACKGROUND

Review of the file history shows that the application was filed on November 23, 1999 as a continuation of copending International Application No. PCT/US98/10719, which claims the benefit of U.S. Provisional Application Serial No. 60/047,472, filed May 23, 1997. The examiner issued two Office actions. After applicants filed a continued prosecution application, the examiner issued two more Office actions, the most recent being a final rejection mailed October 7, 2003. The examiner has since issued two detailed advisory actions in response to amendments after final rejection. On January 15, 2004 applicants submitted an appeal brief. On February 18, 2004 the examiner informed applicants' representative (telephonically) that one claim would be allowable if rewritten in independent form.

DISCUSSION

Applicants request that the examiner be required to re-open prosecution to indicate allowability of the claim in question. Applicants believe that the examiner's offer to allow one claim upon cancellation of the remaining claims was improper. Applicants argue that this would bypass required procedures, and that arguments in the appeal brief for the patentability of the allowable claim (i.e. the arguments which were found persuasive by the examiner) would distract the Board of Patent Appeals and Interferences (BPAI) panel and be unfairly prejudicial. Finally applicants admit a desire to further discuss allowance of the other rejected claims.

These arguments are not persuasive. Applicants cite 37 CFR 1.113(c), which states:

Reply to a final rejection or action must include cancellation of, or appeal from the rejection of, each rejected claim. If any claim stands allowed, the reply to a final rejection or action must comply with any requirements or objections as to form.

Applicants appear to have complied with all requirements of the regulation. The examiner has offered to re-open prosecution, i.e. withdraw finality of the last Office action, only for the purpose of entering an examiner's amendment to put the application in condition for allowance, not to allow applicants a seventh opportunity to argue for the patentability of other rejected claims. No required procedure has been bypassed.

Once an appeal brief has been filed, the examiner is required to hold an appeal conference. As detailed in MPEP 1208,

During the appeal conference, consideration should be given to the possibility of dropping cumulative art rejections and eliminating technical rejections of doubtful value....The examiner responsible for preparing the examiner's answer should weigh the arguments of the other examiners presented during the appeal conference....If any rejection is withdrawn, the withdrawal should be clearly stated in the examiner's answer under "Issues."...The examiner should reevaluate his or her position in the light of the arguments presented in the brief, and should expressly withdraw any rejections not adhered to, especially if the rejection was made in an action which is incorporated by reference.

Applicants' arguments have apparently persuaded the examiner that one claim is allowable. The rejection of that claim will be clearly withdrawn in the examiner's answer, according to the established procedure. This is not expected to confuse the BPAI panel, who are well versed in USPTO examination procedures. Moreover, applicants are reminded that, even if the examiner were to make a new final rejection, the arguments presented in the brief would remain of record in the application file.

DECISION

Applicants' petition is **DENIED**.

The application will be forwarded to the examiner for preparation of an examiner's answer.

Any request for reconsideration or review of this decision must be made by a renewed petition and must be filed within TWO MONTHS of the mailing date of this decision in order to be considered timely.

Should there be any questions with regard to this letter please contact Bruce Campell by letter addressed to the Director, Technology Center 1600, P.O. Box 1450, Alexandria,

VA, 22313-1450, or by telephone at (571) 272-0974 or by facsimile transmission at (571) 273-0974.

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